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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/852,563      | 05/10/2001  | Hirokazu Uchio       | B422-150            | 6252             |

26272 7590 03/29/2005

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EXAMINER

RONES, CHARLES

ART UNIT PAPER NUMBER

2164

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/852,563

Applicant(s)

UCHIO ET AL.

Examiner

Charles Rones

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Amendment**

The amendment timely filed on August 10, 2004 has been entered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Petruzzi et al. U.S. Patent No. 6,049,811 ('Petruzzi').

Petruzzi discloses:

As to claim 27,

accumulation means for accumulating a related prior art document for the patent application; See Fig. 4; 6:1-67; and

display control means for displaying a list of prior art documents of a said patent application; See Fig. 4; 6:1-67; and

a corresponding foreign patent application of said patent application accumulated in said accumulation means; See Fig. 4; 6:1-67.

As to claim 28,

wherein said display control means displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior document; See Fig. 4; 6:1-67.

As to claim 29,

wherein said display control means displays descriptions indicating correspondence between the prior art document and a rejection reason; See Fig. 4; 6:1-67.

As to claim 30,

Wherein said display control means displays a list of applications by which the prior art document has been cited relating to the prior art document; See Fig. 4; 6:1-67.

As to claim 31,

accumulating a related prior art document for the patent application; and  
displaying and controlling a list of prior art documents of a said patent application  
and a corresponding foreign patent application of said patent application  
accumulated in said accumulation step; See Fig. 4; 6:1-67.

As to claim 32,

a code for realizing an accumulation step of accumulating a related prior art document for the patent application; See Fig. 4; 6:1-67; and

a code for realizing a displaying and controlling a list of prior art documents of a said patent application and a corresponding foreign patent application of said patent application accumulated in said accumulation step; See Fig. 4; 6:1-67.

Claims 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al. U.S. Patent No. 6,298,327 ('Hunter').

As to claim 27,

accumulation means for accumulating a related prior art document for the patent application; See 4:21-67; 5:1-54; and

display control means for displaying a list of prior art documents of a said patent application; See 4:21-67; 5:1-54; and

a corresponding foreign patent application of said patent application accumulated in said accumulation means; See 4:21-67; 5:1-54.

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As to claim 28,

wherein said display control means displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior document; See 4:21-67; 5:1-54.

As to claim 29,

wherein said display control means displays descriptions indicating correspondence between the prior art document and a rejection reason; See 4:21-67; 5:1-54.

As to claim 30,

Wherein said display control means displays a list of applications by which the prior art document has been cited relating to the prior art document; See 4:21-67; 5:1-54.

As to claim 31,

accumulating a related prior art document for the patent application; See 4:21-67; 5:1-54; and

displaying and controlling a list of prior art documents of a said patent application and a corresponding foreign patent application of said patent application accumulated in said accumulation step; See 4:21-67; 5:1-54.

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As to claim 32,

a code for realizing an accumulation step of accumulating a related prior art document for the patent application; See 4:21-67; 5:1-54; and

a code for realizing a displaying and controlling a list of prior art documents of a said patent application and a corresponding foreign patent application of said patent application accumulated in said accumulation step; See 4:21-67; 5:1-54.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Rones whose telephone number is 571-272-4085. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "C. Rones". The signature is fluid and cursive, with the first letter "C" being large and prominent.

Charles Rones  
Primary Examiner  
Art Unit 2164

March 24, 2005